

Appl. No. 10/723,441
Amdt date December 27, 2005
Reply to Office action of June 27, 2005

REMARKS/ARGUMENTS

Summary of Office action

Claims 1 - 23 are currently pending in the above referenced patent application. Claims 1 - 17 were rejected and claims 18 - 23 were indicated as being allowable in the Office action dated June 27, 2005. The rejections contained within the Office action can be summarized as follows:

- claims 1, 2 and 10 - 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,027,691 to Kennedy (the Kennedy patent);
- claims 3 - 9 and 14 - 17 were rejected under 35 U.S.C. § 103(a) as being obvious in light of the Kennedy patent in view of U.S. Patent 4,501,186 to Ikuma; and
- claims 1 - 23 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 15 - 37 of copending Application No. 10/735,248.

As indicated above, claims 18 - 23 were indicated as being allowable providing the Applicant cancels the corresponding claims from application serial number 10/735,248.

In response to the Office action, claim 11 has been amended.

Rejection of claims 1, 2 and 10 - 13

Claims 1, 2 and 10 - 13 were rejected as being anticipated by the Kennedy patent. The Kennedy patent describes a "Fiddle Stick" that includes a "combination electromagnetic and contact pickup". The "combination electromagnetic and contact pickup" is described as follows:

The combination electromagnetic and contact pickup is adjustably suspended between the strings and the base segment at the lower end of the finger board. The pickup has a first coil suspended from an adjustable bracket member such that the orientation of the coil with respect to the strings is adjustable. The

first coil has a soft iron core wrapped by a plurality of turns of insulated wire in a predetermined direction. A bar magnet, typically ceramic, is affixed in spaced relation to the first coil at the base of the finger board to produce a magnetic field which interacts with both the coil and the five metallic strings.

A second humbucking coil can be provided which has its insulated wire winding wrapped in an opposite direction to that of the first coil, resulting in an opposing electrical sense. This second coil is suspended behind the magnet and finger board within the elongated body and acts to inhibit electromagnetic feedback and noise.

(Kennedy patent, Col. 2, ln. 52 - Col. 3, ln. 2)

The "combination electromagnetic and contact pickup is shown in FIGS. 5, 6A and 6B (reproduced below):

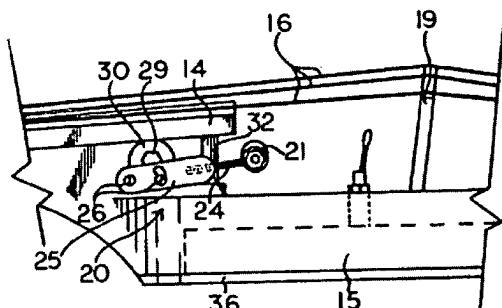


FIG. 5

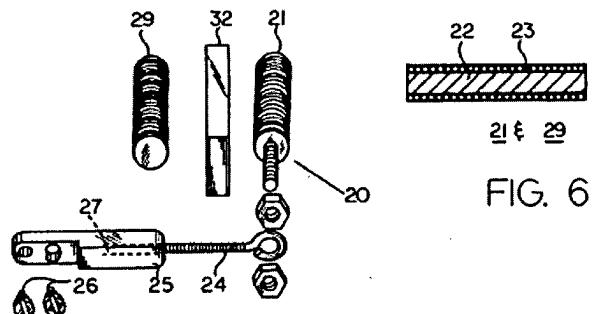


FIG. 6B

The rejection of claims 1, 2 and 10 - 13, in the Office action is accompanied by the following statement:

The Examiner maintains that while the Applicant's structure may differ slightly from that of Kennedy, the relative movement (i.e., by a flexible connection) of coil 21 to pickup assembly 29 and 32 is functionally equivalent to that of the Applicant. Where the Applicant uses a coil to sense relative

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movement, Kennedy uses a moving coil to sense relative movement, i.e., functionally equivalent systems.

(Office action, pg. 2)

Applicants respectfully submit that the above statement is an inappropriate basis for rejection under 35 U.S.C. § 102. The MPEP states "In other words, for anticipation under **35 U.S.C. 102**, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present" (MPEP §706.02). The Office action explicitly acknowledges that every aspect of the claimed invention is not taught by the Kennedy patent. For example, the Kennedy patent teaches a secondary coil flexibly coupled to the body of a stringed musical instrument, whereas claim 1 requires "a secondary coil ... coupled to the primary coil by a flexible suspension mechanism". Therefore, Applicants submit that for reasons, including those stated above, the Kennedy patent does not teach the following from claim 1:

1. A pickup for a stringed musical instrument, comprising:
 - a primary coil magnetically coupled to a string of the musical instrument and fixedly attached to a string support structure;
 - a secondary coil magnetically coupled to the primary coil, the secondary coil further coupled to the primary coil by a flexible suspension mechanism.

Claim 2 depends from claim 1. Applicants respectfully submit that claim 2 is allowable for reasons including that claim 2 depends from an allowable base claim.

For reasons similar to those stated above, Applicants respectfully submit that the Kennedy patent does not teach the following from amended claim 11:

11. A pickup for a stringed musical instrument having a string support structure, comprising:
 - a primary coil, the primary coil having magnetic means for generation of a magnetic field in proximity to the string, the primary coil generating a string signal in response to movement of the string within the magnetic field; and

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a secondary coil electrically coupled to the primary coil in a noise-cancellation circuit, the secondary coil suspended within the primary coil's magnetic field by a suspension means that is coupled to the primary coil whereby the secondary coil vibrates within the magnetic field and generates a string support structure signal in response to vibrations of the string support structure.

Claims 12 and 13 depend from claim 11. Therefore, Applicants respectfully submit that claims 12 and 13 are allowable for reasons including that claims 12 and 13 are dependant upon an allowable base claim.

Rejection of claims 3 - 9 and 14 - 17

Claims 3 - 9 and 14 - 17 were rejected as being obvious in light of the combination of the Kennedy and Ikuma patents. Claim 3 requires the following:

3. The pickup of claim 2, wherein the primary coil further comprises a primary coil winding wound in the same direction as a secondary coil winding in the secondary coil.

Applicants respectfully submit that the Kennedy explicitly teaches away from the use of a "primary coil winding wound in the same direction as a secondary coil winding in the secondary coil." The Kennedy patent teaches that the windings of the primary and secondary coil should be wound in opposite directions:

The pickup has a first coil suspended from an adjustable bracket member such that the orientation of the coil with respect to the strings is adjustable. The first coil has a soft iron core wrapped by a plurality of turns of insulated wire in a predetermined direction. ...

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A second humbucking coil can be provided which has its insulated wire winding wrapped in an opposite direction to that of the first coil, resulting in an opposing electrical sense.

(Kennedy patent, Col. 2, Ins. 54 - 67)

Therefore, Applicants respectfully submit that claim 3 is allowable for reasons including that the Kennedy patent explicitly teaches away from the invention of claim 3.

With respect to claims 4 - 6 and 14, the Office action contains the following statements:

Regarding claims 4 - 6 and 14, Kennedy does not disclose the use of securing the pickup to a soundboard having a sound hole or within a recess of the soundboard. Ikuma discloses mounting a two pickup system, wherein a first transducer senses a second transducer and wherein the system is located within a soundboard recess. The motivation for making this combination is that most acoustic guitars have a soundboard and sound hole, mounting the pickup within the sound hole provides both proximity to the strings and easy-to-mount capability.

(Office action, pg. 3)

Were Applicants to agree that one of ordinary skill in the art would be motivated to combine teachings from the Kennedy and Ikuma patents, which Applicants do not, Applicants respectfully submit that neither the Kennedy nor the Ikuma alone or in combination teach the limitations of claim 1 and 11. Claims 4 - 6 depend from claim 1 and claim 14 depends from claim 11. Therefore, Applicants respectfully submit claims 4 - 6 and 14 are allowable for reasons including that they are dependent upon allowable base claims.

With respect to claims 7 - 9 and 15 - 17, the Office action contains the following statement:

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Regarding the limitations in claims 7 - 9 and 15 - 17, the choice of resonant frequency, spring constant, coil mass, are deemed to be mere matters of design choice and chosen for optimizing operation. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

(Office action, pp. 3 - 4)

Claims 7 - 9 and 15 - 17 depend from claims depend form either claim 1 or claim 11. For reasons including those discussed above, Applicants respectfully submit that the general conditions of claims 1 and 11 are not disclosed in the prior art. Therefore, the rejection of claims 7 - 9 and 15 - 17 for the reasons stated in the Office action is inappropriate.

Provisional rejection of claims 1 - 23

Applicants respectfully submit that claims 1 - 23 are not obvious in light of the claims of copending U.S. Patent Application Serial No. 10/735,248. However, for reasons unrelated to the currently pending application U.S. Patent Application Serial No. 10/735,248 has been expressly abandoned. A copy of the express abandonment submitted in accordance with 37 CFR § 1.138 is enclosed.

Claims 18 - 23 were indicated as allowable

As indicated above U.S. Patent Application Serial No. 10/735,248 has been expressly abandoned.

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Conclusion

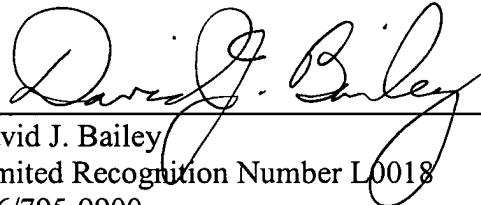
Applicants respectfully submit that claims 1 - 23 are allowable for reasons including those stated above. Consequently, Applicants request the prompt issuance of a Notice of Allowability.

If Applicants counsel can be of assistance in this matter, please feel free to contact David J. Bailey at the number listed below.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By _____



David J. Bailey
Limited Recognition Number L0018
626/795-9900

DJB/lb

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